

06-08-06

DAC
ZTW

DOCKET NO.: GLIS-0128

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Buhr, et al.

Application No.: 09/408,396

Filing Date: September 29, 1999

For: Nucleoside 5'-Methylene Phosphonates

Confirmation No.: 4009

Group Art Unit: 1623

Examiner: D. Khare

EXPRESS MAIL LABEL NO: EL998522215US
DATE OF DEPOSIT: June 6, 2006

EL998522215US

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**RESPONSE TO ORDER TO SHOW CAUSE AND
PETITION FOR DELAYED PAYMENT OF
MAINTENANCE FEES PURSUANT TO 37 CFR § 1.378(b)**

On May 16, 2006, the PTO mailed an Order to Show Cause in connection with this reissue application advising Applicants that the PTO's financial records indicate that the 3.5 year maintenance fee for U.S. Patent No. 5,672,697 (the patent for which reissue is sought) had not been paid by its September 20, 2001, due date, and that the 7.5 year maintenance fee had not been paid by its September 30, 2005, due date. The Order to Show Cause sets a 30-day deadline for response.

U.S. Patent No. 5,672,697 (hereinafter, "the 697 Patent") appears to have expired on October 1, 2001, for failure to pay the maintenance fee that was due on September 30, 2001. Applicants therefore respectfully petition pursuant to 37 CFR § 1.378(b) for acceptance of the past-due maintenance fees and reinstatement of the 697 Patent. Upon reinstatement of the patent, Applicants ask that post-allowance prosecution of the reissue application be permitted to proceed.

Applicants' delay in paying the requisite maintenance fees is believed to have been unavoidable, and occurred despite their exercise of reasonable care. ISIS Pharmaceuticals, Inc., acquired a portfolio of patents and patent applications including the 697 Patent in 1998. Since that time, ISIS has used a computerized docketing system to monitor due dates and other activities related to the portfolio.

Following receipt of the Order to Show Cause, Applicants reviewed the docketing system's database for information relating to the 697 Patent, and also reviewed files that potentially could relate to the patent. Applicants found that the paralegal who entered that information into the database after ISIS acquired the patent mistakenly identified its status as "inactive." That this error was simply one of data entry is indicated by the fact that other patents in the acquired portfolio are not identified in the database as "inactive." Because the docketing system understood the 697 Patent to be inactive, none of the prompts or reports that the system subsequently generated concerning the acquired portfolio identified maintenance fees that were due in connection with the patent. Although the paralegal appears to have received a notice of patent expiration in the March, 2002, timeframe, no such notice can be found in Applicants' files, nor is the undersigned or anyone currently employed in ISIS' patent department aware of ever having seen it.

Upon receiving the Order to Show Cause, Applicants promptly prepared and filed this petition to address the past-due maintenance fees identified therein.

Applicants enclose with herewith a check in the amount of \$4860 representing:

- the 3.5 year maintenance fee (\$900) and grace period fee (\$130), other than small entity, pursuant to 37 C.F.R. § 1.20(e) and 1.20(h)
- the surcharge (\$700) on the 3.5 year maintenance fee, other than small entity, pursuant to 37 C.F.R. § 1.20(i)
- the 7.5 year maintenance fee (\$2300) and grace period fee (\$130), other than small entity, pursuant to 37 C.F.R. § 1.20(f) and 1.20(h)

- the surcharge (\$700) on the 7.5 year maintenance fee, other than small entity, pursuant to 37 C.F.R. § 1.20(i).¹

In view of the foregoing, Applicants respectfully request that the past-due fees be accepted and that the 697 Patent be reinstated so that prosecution of the instant reissue application can proceed.

Respectfully submitted,

Date: June 6, 2006



Joseph Lucci
Registration No. 33,307

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439

© 2006 WW

¹ The Commissioner is hereby authorized to charge any deficiency or credit any overpayment of the fees associated with this communication to Deposit Account No. 23-3050.